REMARKS/ARGUMENTS

I. General

Claims 1-14, 16-18, and 20-22 are pending in the current application. The issues raised in the Office Action mailed May 21, 2003 are:

- Claims 1-4, 8-10, 13, and 16-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,108,492 to Miyachi (hereinafter "*Miyachi*");
- Claims 5 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of U.S. Patent Number 6,266,693 B1 to Onaga (hereinafter "*Onaga*");
- Claims 6-7, 14, and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of Transact-SQL User's Guide (hereinafter "*SQL User's Guide*"); and
- Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of *Onaga* and further in view of *SQL User's Guide*.

Applicant respectfully traverses the outstanding rejections, and requests reconsideration and withdrawal thereof in light of the remarks contained herein.

II. Claim Rejections Under 35 U.S.C. § 103(a) over *Miyachi*

Claims 1-4, 8-10, 13, and 16-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi*. In view of the comments below, Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding any other criteria, Applicants respectfully assert that the rejection

does not satisfy the first and third criteria, as discussed further below.

1. *Miyachi* Fails to Teach All Claim Limitations

Applicants respectfully submit that *Miyachi* fails to teach or suggest all the limitations of independent claims 1, 13, and 18.

Claim 1 recites in part:

> receiving a request from a client to notify said client of a condition of an attribute of a system, wherein said request comprises information specifying a query for said system attribute ... (Emphasis added).

Claim 13 recites in part:

> computer executable software code for receiving from a client a request to notify said client of a condition of an attribute of a system, wherein said request comprises information specifying a query for said system attribute ... (Emphasis added).

Claim 18 recites in part:

> wherein said reporting application includes computer executable software code for receiving from a client application program a request to notify said client application program of a condition of an attribute of a system, said request comprising information specifying a query for said system attribute... (Emphasis added).

Applicants respectfully submit that *Miyachi* fails to teach or suggest at least the above limitations of independent claims 1, 13, and 18. Specifically, *Miyachi* fails to teach or suggest receiving at a reporting application a request from a client, wherein the request includes information specifying a query for a system attribute.

The Examiner concedes at page 4 of the present Office Action that *Miyachi* does not explicitly teach that the request comprises information specifying a query for said system attribute; and using said query for monitoring said system for the existence of said condition of said attribute. However, the Examiner asserts on page 5 of the present Office Action that the *Miyachi* technique "indicates the request comprises information specifying a query for said system attribute; and using said query for monitoring said system for existence of said condition of said attribute." More specifically, the Examiner contends that *Miyachi* teaches that a technician is allowed to select a number of MFP conditions to monitor and may also select a number of trigger conditions to trigger notification. The Examiner concludes that "it would have been obvious for one of ordinary skill in the art at the time the invention was

made to modify the Miyachi method by using query for monitoring condition of system attributes in order to maintain and repair electronic devices in a network." Page 5 of Office Action. That is, the Examiner contends that it would have been obvious from the teaching of *Miyachi* to one of ordinary skill in the art at the time the invention was made to modify *Miyachi* such that a user submits a request specifying a query for system attribute(s) rather than selecting predefined trigger conditions in the manner taught by *Miyachi*. Applicants respectfully disagree, as discussed further below.

Miyachi teaches a data processing system that comprises a multi-function peripheral (MFP) and a Host, wherein the MFP periodically stores its status information and the Host periodically receives this status information and stores it in a database in the Host. Col. 3, lines 60-64 (Summary of the Invention). "A technician may select some or all of the information to be provided to the technician on the occurrence of a number of trigger conditions." Col. 3, lines 64-66 (Summary of the Invention). "The technician may set the trigger conditions from any of the reportable status conditions." Col. 3, line 66 - col. 4, line 1 (Summary of the Invention). A technician may select a number of the MFP status conditions to monitor (Col. 9, lines 40-42) and may also select a trigger condition to trigger notification of the technician. Col. 9, lines 55-59.

Miyachi teaches a technique of selecting trigger conditions and fails to suggest that a user can form a query. More specifically, *Miyachi* fails to teach or suggest that a client can submit a request to be notified of a condition of an attribute of a system wherein the request comprises information specifying a query for the system attribute. For instance, the user in *Miyachi* does not specify a query for a system attribute. Rather, the user may select certain ones of predefined trigger conditions that are available for selection, such as those shown in Tables 1 and 2 of *Miyachi*.

Thus, the technique of *Miyachi* makes a list of predefined trigger conditions available for selection by a user, rather than allowing a user to specify a query in a request for notification. An analysis of the database (e.g., to determine whether a trigger condition is satisfied) in *Miyachi* is necessarily limited to the information collected by the MFP. A technician is not able to submit a request specifying a query of the system, but can instead only select trigger conditions for information that is collected in the Host's database. If, for example, the technician desires to be notified about a condition of a system attribute that is

not reported by the MFP, the system of *Miyachi* does not permit the technician to select a trigger condition for such an attribute (as it is not included in the Host's database). *Miyachi* fails to make any suggestion regarding the desirability of specifying a query in a request for notification, but rather such suggestion is provided in the present application.

Based on the arguments stated above, *Miyachi* does not teach each and every element of independent claims 1, 13, and 18. Therefore, independent claims 1, 13, and 18 are not obvious over *Miyachi*.

Additionally, Claim 13 recites:

computer executable code for querying said system as specified by said request.....

Applicants respectfully submit that *Miyachi* fails to teach or suggest at least the above element of independent claim 13. *Miyachi* states that after "the Host's processor 230 has generated a signal to the MFP's processor 235 to request the current status information (step 440), the Host's processor 230 uses this status information to update the Host's MFP status database stored in the data storage device 240 (step 445)." Col. 10, lines 45-50. The *Miyachi* reference also states, "if the process is to continue, the processor 230 analyzes the status information database (step 455) and determines if any of the trigger conditions have been met (step 460)." Col. 10, lines 54-57. As such, *Miyachi* teaches analyzing the status information database to determine if any trigger conditions have been met. The Host requests an update of status information from the MFP, stores that information into the status information database, and then periodically checks the status information database to determine if a trigger has been met.

Thus, to the extent that a trigger condition is selected in *Miyachi*, the status information database is analyzed for such trigger condition, rather than the system being queried as specified by a received request. For instance, *Miyachi* teaches that, irrespective of a selected trigger condition (or any other received request), an MFP collects certain status information. A Host requests the collected status information and stores it to a database, and such database may be analyzed to determine whether a selected trigger condition is satisfied. Thus, the system is not queried as specified by a received request, but rather the MFP collects certain status information irrespective of any request that may be received.

Further, as mentioned above, an analysis of the database (e.g., to determine whether a trigger condition is satisfied) is necessarily limited to the information collected by the MFP. A technician is not able to submit a request specifying a query of the system, but can instead only select trigger conditions for information that is collected in the Host's database. If, for example, the technician desires to be notified about a condition of a system attribute that is not reported by the MFP, the system of *Miyachi* does not permit the technician to select a trigger condition for such an attribute (as it is not included in the Host's database).

2. Improper Motivation to Modify *Miyachi*

It is well settled that sufficient motivation must be provided to establish a prima facie case of obviousness. *See* M.P.E.P. § 2143. In the Examiner's arguments, there is improper motivation to modify *Miyachi* in the manner suggested by the Examiner. As mentioned above, *Miyachi* does not teach or suggest the use of receiving a query from a client. Rather, *Miyachi* simply states that a technician is able to set a trigger condition to any reportable status condition. Applicants respectfully assert that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure, *see* M.P.E.P. § 2145(X)(A). The motivation supplied in the Office Action is derived from the Applicants' disclosure, *see* page 7, lines 20-24. The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. *See* M.P.E.P. §2143, *citing In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Thus, the motivation to modify *Miyachi* in the manner proposed by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a modification. As such, the proposed modification of *Miyachi* is improper, and therefore, the rejected claims are not obvious under 35 U.S.C. § 103(a).

III. Dependent Claims 2-12, 14, 16-17, and 20-22

In view of the above, Applicants submit that independent claims 1, 13, and 18 are allowable over the applied reference. Further, dependent claims 2-12, 14, 16-17, and 20-22 each depend either directly or indirectly from one of independent claims 1, 13, and 18 and thus inherit all of the limitations of their respective independent claims. It is respectfully submitted that dependent claims 2-12, 14, 16-17, and 20-22 are allowable not only because of their dependencies from their respective independent claims 1, 13, and 18 for the reasons

discussed above, but also in view of their novel claim features which narrow the scope of the particular claims and compel a broader interpretation of the independent claims from which they depend.

Rejections under 35 U.S.C. § 103(a) over *Miyachi* in view of *Onaga*

Claims 5 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of *Onaga*. Such claims 5, 11, and 12 depend from independent claim 1 and therefore inherit all of its limitations. *Onaga* does not cure the deficiencies discussed above, and as such, claims 5, 11, and 12 are allowable based on the arguments stated above.

Rejections under 35 U.S.C. § 103(a) over *Miyachi* in view of *SQL User's Guide*

Claims 6-7, 14, and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of *SQL User's Guide*. Such claims 6-7, 14, and 20-22 each depend from one of independent claims 1, 13, and 18 and therefore inherit all of the limitations of their respective independent claim. *SQL User's Guide* does not cure the deficiencies discussed above, and as such, claims 6-7, 14, and 20-22 are allowable based on the arguments stated above. Further, as discussed in Applicants' response of April 16, 2003, proper motivation does not exist for combining *Miyachi* with the *SQL User's Guide* in the manner suggested by the Examiner. For instance, Applicants respectfully assert that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure, *see* M.P.E.P. § 2145(X)(A). Further, Applicants' respectfully assert that the applied combination impermissibly changes the principle of operation of *Miyachi*. Thus, the applied combination of *Miyachi* and the *SQL User's Guide* is improper under 35 U.S.C. §103(a).

Rejection under 35 U.S.C. § 103(a) over *Miyachi* in view of *Onaga* and *SQL User's Guide*

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Miyachi* in view of *Onaga* and further in view of *SQL User's Guide*. Such claim 12 depends from independent claim 1, and therefore inherits all of the limitations of its independent claim. Combining *Onaga* and *SQL User's Guide* with *Miyachi* does not cure the deficiencies discussed above, and as such, claim 12 is allowable based on the arguments stated above. Further, as discussed in Applicants' response of April 16, 2003, proper motivation does not exist for combining *Miyachi* with the *SQL User's Guide* in the manner suggested by the Examiner. For instance, Applicants respectfully assert that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure, *see* M.P.E.P. § 2145(X)(A). Further, Applicants' respectfully assert that the applied combination impermissibly changes the principle of operation of *Miyachi*. Thus, the applied combination of *Miyachi*, *Onaga*, and the *SQL User's Guide* is improper under 35 U.S.C. §103(a).

IV. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10990763-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 256034337US in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: July 22, 2003

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